REMARKS

This Amendment is being filed in response to a final Official Action on a Request for Continued Examination (RCE), and concurrent with a second RCE for the above-identified, present application. The Official Action continues to reject Claims 1, 6, 9, 11-13, 17-20, 24-29, 34 and 36-39 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,130,908 to Pecus et al. The Official Action then continues to reject the remaining claims, namely Claims 2-5, 7, 14-16, 21-23, 30-33 and 35, under 35 U.S.C. § 103(a) as being unpatentable over Pecus, in view of U.S. Patent No. 6,157,982 to Deo. As explained below, however, Applicants respectfully submit that the claimed invention is patentably distinct from Pecus and Deo, taken individually or in any proper combination. Nonetheless, Applicants have amended various ones of the claims to further clarify the claimed invention. In view of the amendments to the claims and the remarks presented herein, Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application.

A.   Claims 1, 6, 9, 11-13, 17-20, 24-29, 34 and 36-39 are Patentable

As indicated, the Official Action continues to reject Claims 1, 6, 9, 11-13, 17-20, 24-29, 34 and 36-39 as being anticipated by Pecus. Appellants first note that anticipation of a claim requires a single cited reference to explicitly or inherently disclose each and every element of the claimed invention. MPEP § 2131. As explained in the MPEP, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112, quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). And as explained below, Pecus does not explicitly or inherently (necessarily, if not explicitly) disclose each and every element of Claims 1, 6, 9, 11-13, 17-20, 24-29, 34 and 36-39.

According to one aspect of the claimed invention, as reflected by amended independent Claim 12, an apparatus is provided that includes a processor and a memory storing executable instructions that in response to execution by the processor cause the apparatus to perform a number of functions. As recited, these functions include sending, to another apparatus located

remote from the apparatus, a status of at least one piece of content stored in memory of the apparatus, where each piece of content is associated with parameters including a client expiration time and a deletion priority value. In addition, the functions include sending one or more instructions from the network entity based upon the status and the associated parameters, including the client expiration time and deletion priority value, to at least partially control storage of the piece(s) of content in memory of the apparatus.

In contrast to amended independent Claim 12, Pecus does not explicitly or inherently (necessarily, if not explicitly) disclose a remote apparatus configured to at least partially control storage of content in memory of another apparatus based upon the status of the content received from the terminal, and a client expiration time and deletion priority value associated with the content. Pecus discloses a satellite-based content delivery system including a network operations center (NOC) that delivers content and command packages to an edge node (EN). Pecus discloses that content stored by the EN may include an expiration time and forced deletion flag according to which the EN (or rather a data manager of the EN) may make decisions as to the deletion of locally-stored content. This, however, does not correspond to remotely controlling storage of content in memory, as per amended independent Claim 12.

Pecus does also disclose its NOC sending command packages to its EN to remotely control the EN. As disclosed, one of these commands may be a "DeleteContent" command from the NOC that directs the EN to delete locally-stored content listed in the command. And another of these commands may be a "RequestFileStatus" command from the NOC that directs the EN to provide the NOC with the status of locally-stored content, including the expiration times and forced deletion flag status of that content. Even given this disclosure, however, Pecus still does not explicitly or inherently (necessarily, if not explicitly) disclose the NOC making any decisions as to what content to direct the EN to delete based upon the expiration time and forced deletion flag, similar to the apparatus of amended independent Claim 12 sending instructions to the apparatus based upon the status and parameters to thereby control storage of content. Rather, Pecus does not disclose any particular basis for the NOC selecting the content of the EN to be deleted.

Applicants therefore respectfully submit that amended independent Claim 12, and by dependency Claims 13-18, is patentably distinct from Pecus. Amended independent Claims 1, 19, 29 and 39 recite subject matter similar to that of independent Claim 12, including the aforementioned controlling storage of content at a terminal based on multiple parameters associated with the content, and sending instructions from a remote network entity or apparatus to control storage of such content. Thus, Applicants also respectfully submit that amended independent Claims 1, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 20-28 and 30-38, are also patentably distinct from Pecus, taken individually or in any proper combination, for at least the reasons given above with respect to amended independent Claim 12.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1, 6, 9, 11-13, 17-20, 24-29, 34 and 36-39 as being anticipated by Pecus is overcome.

B. Claims 2-5, 7, 14-16, 21-23, 30-33 and 35 are Patentable

The Official Action continues to reject Claims 2-5, 7, 14-16, 21-23, 30-33 and 35 as being unpatentable over Pecus, in view of Deo. As explained above, amended independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus. Applicants respectfully submit that Deo does not cure the deficiencies of Pecus. That is, even considering Deo, neither Pecus nor Deo, taken individually or in any proper combination, teaches or suggests the aforementioned controlling storage of content at an apparatus based on multiple parameters associated with the content, and sending instructions from another, remote apparatus to control storage of such content, as per amended independent Claims 1, 12, 19, 29 and 39. Applicants therefore respectfully submit that amended independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus, in view of Deo.

1. No Apparent Reason to Combine Pecus and Deo

Moreover, Applicants again respectfully submit that there is no apparent reason for the combination of Pecus and Deo, and the Official Action does not provide sufficient reasoning for their combination. Applicants again acknowledge that the Supreme Court's recent decision in

KSR Int'l. Co. v. Teleflex, Inc., 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007), rejected a rigid application of the "teaching, suggestion or motivation" (TSM) test. Nonetheless, the Court did state that obviousness often requires determining whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue, and that to facilitate review, this analysis should be made explicit. *See KSR Int'l. Co.*, 127 S.Ct. at 1740–41, 82 USPQ2d (BNA) at 1396. Even further, the Court noted that "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, 127 S.Ct. at 1740-41, 82 USPQ2d (BNA) at 1396, *citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d (BNA) 1329 (Fed. Cir. 2006) (emphasis added).

As clearly explained by the Supreme Court, then, any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. In the instant case, the Examiner attempts to support the alleged combination of Pecus and Deo by merely asserting that one skilled in the art would have been led to the combination to "decrease the processing burden of a terminal that has less processing power than a computer it is networked with." Official Action of Jul. 22, 2008, p. 8 (citing as support Deo, col. 2, l. 65 – col. 3, l. 4). However, the Official Action fails to provide any articulated reasoning with any rational underpinning to support this conclusion.

More particularly, the Official Action fails to provide any articulated reasoning with any rational underpinning to support the particular modification of the EN (alleged terminal) of Pecus per Deo. That is, even if the system of Deo does generally decrease the processing burden of a processing-limited terminal, the Official Action fails to make the connection between that general benefit of Deo and the particular system of Pecus. In this regard, the alleged benefit of Deo applies to processing-limited devices, but nowhere has the Official Action alleged or explained that the EN of Pecus is a processing-limited device that would benefit from a reduction in its processing burden to the extent that it actually would have been obvious to one skilled in the art to modify Pecus as alleged. In fact, Pecus discloses its EN includes a controller that may be implemented by a general purpose computer or workstation, such as a PowerEdge server or Power Macintosh G4 server, clearly running contrary to any suggestion that a reduction in the

processing burden on its EN is a concern that would lead one to modify the EN per Deo. *See* Pecus, col. 15, ll. 51-57.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 2-5, 7, 14-16, 21-23, 30-33 and 35 as being unpatentable over Pecus, in view of Deo is overcome. In addition to the foregoing reasons, Applicants respectfully submit that various ones of dependent Claims 2-7, 9, 11, 13-18, 20-28 and 30-38 recite features further patentably distinct from Pecus and Deo, taken individually or in any proper combination. Examples of such dependent claims, including Claims 2-5, 7, 13-16, 20-23, 25, 30-33 and 35, are explained below.

2. *Dependent Claims 2, 13, 20 and 30*

Dependent Claims 2, 13, 20 and 30 recite sending or receiving instruction(s) to delete content based upon <u>a comparison between the deletion priority values</u> of a plurality of pieces of content stored in memory of the terminal, which is also absent from Pecus and Deo, taken individually or in any proper combination. The Official Action cites Pecus for allegedly disclosing a deletion priority value upon which a decision to delete content may be based, the aforementioned forced deletion flag of Pecus allegedly corresponding to the recited deletion priority values. Even if one could argue that the disclosed forced deletion flag of pieces of content of Pecus could correspond to the recited deletion priority values of pieces of content (the accuracy of which is expressly not admitted), Pecus does not teach or suggest any comparison between the flags of the pieces of content, similar to Claims 2, 13, 20 and 30. Instead, Pecus discloses deciding whether to delete a piece of content based on whether the forced deletion flag is set to "true," irrespective of the forced deletion flags of any other pieces of content or any comparison between those flags.

The final Official Action cites column 17, lines 20-24 of Pecus as disclosing the aforementioned feature, stating that Pecus discloses that its data manager "checks for files marked for forced deletion; i.e. a plurality of files' forced deletion flag is compared with the Boolean value 'true' to determine if they should be deleted." Final Official Action of Dec. 23, 2008, page 4. However, Applicants respectfully submit that a comparison of forced deletion

flags with the Boolean value "true" is not the same as a comparison between deletion priority values of pieces of content, as per dependent Claims 2, 13, 20 and 30.

3.   *Dependent Claims 3, 4, 14, 15, 21, 22, 31 and 32*

Dependent Claims 3, 14, 21 and 31, which depend from respective ones of Claims 2, 13, 20 and 30, and from which Claims 4, 15, 22 and 32 depend, recite <u>sending or receiving instruction(s) to delete content having the highest deletion priority value from a comparison between the deletion priority values of content having an exceeded client expiration time, where the comparison excludes any piece of content without an exceeded client expiration time</u>. This feature is also absent from Pecus and Deo, taken individually or in any proper combination. The Official Action cites Pecus for allegedly disclosing determining content having an exceeded client expiration time, and from that content, deleting content having the highest deletion priority value. Again, even if one could argue that the disclosed forced deletion flag of pieces of content of Pecus could correspond to the recited deletion priority values of pieces of content, Pecus does not teach or suggest any comparison between the flags of the pieces of content, similar to Claims 2, 13, 20 and 30, and also Claims 3, 4, 14, 15, 21, 22, 31 and 32.

Further, nowhere does Pecus teach or suggest determining content having an exceeded client expiration time, and from that content, identifying content having the highest deletion priority value (thereby identifying content that is both expired and has the highest deletion priority value), as recited by dependent Claims 3, 14, 21 and 31, and by further dependency Claims 4, 15, 22 and 32. That is, following the assertions in the Official Action, nowhere does Pecus teach or suggest determining expired content, and from that content, identifying content having the highest forced deletion flag (thereby identifying content that is both expired and has the highest forced deletion flag). Instead, Pecus treats its expiration time and forced deletion flag separate from one another in deciding whether to delete content. More particularly, Pecus discloses deleting all of the expired content or content marked for forced deletion; or first deleting content marked for forced deletion, and then expired content.

4.   Dependent Claims 5, 16, 23 and 33

Dependent Claims 5, 16, 23 and 33, which depend from respective ones of Claims 3, 14, 21 and 31 by way of respective ones of Claims 4, 15, 22 and 32, recite sending or receiving instruction(s) to <u>delete content having an exceeded client expiration time, and from any remaining content, delete content having the highest deletion priority value</u>, which is also absent from Pecus and Deo, taken individually or in any proper combination. Pecus does disclose deleting content marked for forced deletion (alleged deletion priority value), and then expired content (alleged exceeding client expiration time) – i.e., <u>first forced deletion, then expired</u>. But even given this disclosure, Pecus does not teach deleting expired content, and then content having the highest deletion priority – i.e., <u>first expired, then highest deletion priority value</u>, similar to Claims 5, 16, 23 and 33.

5.   Dependent Claims 7, 25 and 35

Further as to dependent Claims 7, 25 and 35, neither Pecus nor Deo, taken individually or in any proper combination, teach or suggest <u>a server expiration time</u> according to which content may be deleted from a network entity or apparatus (separate from the terminal with content associated with a client expiration time according to which locally-stored content may be deleted). The Official Action cites Pecus for allegedly disclosing this feature, with the Official Action alleging that the NOC of Pecus corresponds to the recited network entity. Applicants respectfully submit, however, that nowhere does Pecus disclose its NOC monitors an expiration time (server expiration time) of its locally-stored content, and deletes content having an expired expiration time (server expiration time). Rather, Pecus only discloses deleting content locally-stored by its EN, and based upon a single expiration time (allegedly corresponding to the recited client expiration time). Thus, not only does Pecus not teach or suggest its alleged network entity deleting locally-stored content based upon monitoring an expiration time, Pecus does not teach or suggest multiple expiration times associated with a piece of content. That is, Pecus does not teach or suggest both a client expiration time (from which content may be deleted from memory of a terminal), and a server expiration time (from which content may be deleted from the

network entity that sends the content to the terminal), as recited by dependent Claims 7, 25 and

35.

CONCLUSION

In view of the amended claims and the remarks presented above, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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